



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,336	10/30/2001	Bernhard Lettmann	IN-5530	2515
26922	7590	09/24/2007		
BASF CORPORATION Patent Department 1609 BIDDLE AVENUE MAIN BUILDING WYANDOTTE, MI 48192			EXAMINER ASINOVSKY, OLGA	
			ART UNIT 1711	PAPER NUMBER
			NOTIFICATION DATE 09/24/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LORI.HASS@BASF.COM
MARJORIE.ELLIS@BASF.COM
ANNE.SABOURIN@BASF.COM

Office Action Summary	Application No. 10/018,336	Applicant(s) LETTMANN, BERNHARD	
	Examiner Olga Asinovsky	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,12,13,18,19,21,22,25,26 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) 12,13 and 29-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 18-19, 21-22, 25-26 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Application 10/018,336 returned to the examiner by the Board of Patent Appeals and Interferences of September 05, 2007.
2. In view of the Applicant's Reply Brief under 37 CFR 41.41(a)(1) filed on April 04, 2007 and Amendment under 37 CFR 1.111 filed on June 25, 2007, PROSECUTION IS HEREBY REOPENED. The Supplemental Examiner's Answer was filed on April 24, 2007. In Response to the Supplemental Examiner's Answer, Applicants request that prosecution on the merits be reopened filed in the Amendment on June 25, 2007, page 1. This request is considering. The pending claims in the Applicant's Reply Brief of April 04, 2007 and in the Amendment of June 25, 2007 are the same including claims 3, 18-19, 21-22, 25-26 and 28. There is no amendment to the pending claims 3, 18-19, 21-22, 25-26 and 28. There is no affidavit or other evidence in the Remarks of June 25, 2007. Claims 12-13, 29-32 are withdrawn from consideration as not directed to the elected invention.
3. The rejection of claims 3, 18-19, 21-22, 25-26 and 28 are set forth below. There is no new ground of rejection. The rejection is adequately set forth from the paragraph (9) of the Supplemental Examiner's Answer mailed on 04/25/2007.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 1711

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 18-19, 21-22, 25-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reusmann et al. U.S. Patent 6,403,701 in view of Kawakami et al. EP 0 081 994.

Independent claim 3 and dependent claims 18-19, 21-22, 25-26 and 28 discloses a process for preparing an aqueous coating material with precisely defined shade and optical effect comprising mixing modules different in material composition and functional and stored separately from one another, shortly before application of the coating material, wherein the modules comprise: (I) at least one module containing less than 5% by weight water and said module provides at least one of color and effect comprising at least one binder (a11), at least one pigment (a12) and at least one organic solvent to form a base color (A1); (II) at least one aqueous color module comprising at least one water-soluble or –dispersible binder (a21), at least one color pigment (a22) and water (a23) to form at least one aqueous color-imparting base color (A2); and (III) at least one pigment-free mixing varnish module comprising (B) at least one aqueous, pigment-free mixing varnish comprising (b1) at least one water-soluble or –dispersible binder, and (b2) water; and optionally at least one rheology control additive (C). In other words, the claimed process for preparing an aqueous coating material comprises step of preparing modules (I), (II) and (III) which are stored separately and mixing said modules (I), (II) and (III) shortly before application.

Claim 3 and their dependent claims are stand together.

Reusmann discloses a process for preparing water-dilutable coating compositions with precisely defined tinting, comprising the steps of: preparing a plurality of base colors; separately storing each of said base colors, and mixing, shortly before application of the coating composition, columns 17-18, claim 12, for the present claimed process in claim 3. The water-dilutable coating compositions comprises a plurality of base colors (A) and at least one pigment-free component (B), and at least one rheology-controlling additive, column 17, lines 1-6, 29-30 and 31-32. The base colors (A) comprise less than 5% by weight of water, at least one pigment, an organic solvent, and at least one water-dilutable first binder. The component (B) comprises a pigment-free an aqueous dispersion of polyurethane resin=second binder, column 3, lines 1-3 and claim 1 at column 17, lines 5-17. The component (A) is readable for being claimed (A-1) base color in the claimed module (I), in the present claim 3. The component (B) is readable for being claimed aqueous, pigment-free varnish module (III), in the present claim 3. The first binder (A) and the second binder in the component (B) can be the same binder, column 13, lines 25-26; column 4, lines 52-55 and column 9, lines 7-12. The polyurethane resins as binders are readable in the present claims 25-26. A rheology additive is readable for being the optionally claimed component (C) in the present claim 3 and 21-22. The polyurethane resins can be prepared from an isocyanate-functional prepolymer wherein said functional group is capable of forming anions, column 6, lines 10-14 and 37-41; column 7, lines 14-20 and column 11, lines 18-33, for the present claim 28. Suitable groups capable of forming anions are carboxyl groups, column 7, lines 57-58, for the present claim 28. The coating composition

Art Unit: 1711

comprises a plurality of base colors (A). The base colors (A) comprise a combination of at least one organic coloring pigment and at least one inorganic coloring pigment, column 12, lines 56-59 and column 3, lines 7-35, for the present claim 18. Suitable special-effect pigments at column 3, lines 18-28 is also can be present, for the present claim 19. The coloring pigments and special-effect pigments are readable in claimed (A1) to form module (I) in the present claim 3. The solvents are water-soluble or water-thinnable solvents such as alcohols, column 4, lines 61-62, for the present claim 3. Reference discloses a process for preparing components (A) and (B), and directly after their preparation by mixing the components (A) and (B), the coating compositions are applied to the substrate, column 13, lines 43-55. The coating compositions can be applied by spraying on various substrates, wherein the substrates include metal, wood, plastic or paper, column 13, line 43 through column 14, line 17. The base colors compositions (A) can be mixed with a suitable amount of the aqueous component (B). Reusmann discloses a formulation of a water-dilutable coating composition, which can be deluted with water, with or without prior partial removal of the organic solvent employed in the preparing resin, column 11, lines 30-32; column 12, lines 1-7 and column 13, lines 7-17.

The difference between the present claims and Reusmann invention is that Reusmann does not disclose a (A-2) component of an aqueous coating composition comprising a color-imparting pigment, binder and water.

Art Unit: 1711

Kawakami discloses compositions for an aqueous coating a paper. A composition includes a conventional pigment, binder and water, abstract and page 1, line 1; page 2, lines 30-32; page 3, lines 1-8; page 8, lines 13, 23-24 and 29-32.

Both references disclose an aqueous coating composition comprising a colorant such as for example, titanium dioxide, binder and water. Both references disclose the same utility of using an aqueous coating composition for coating a paper substrate.

It would have been obvious to one of ordinary skill in the art to modify the aqueous coating composition in Reusmann invention by incorporating the composition of Kawakami in order to impart enhanced water resistance and desired solids content and physical properties of coating composition, because the addition composition based on binder, conventional pigment and water could be expected in Reusmann invention for obtaining the desired coating color and the desired solid content with the intended use of the aqueous coating composition in Reusmann at column 13, lines 11-17, and because a color-imparting pigment is present in the resulting aqueous coating composition in Reusmann invention.

(10) Response to Argument

The examiner would like to note that appellants do not traverse the Examiner's position that the aqueous coating composition in Reusmann invention comprises a plurality of base colors (A) comprising color-effect pigment and coloring pigment, organic solvent and binder; and a pigment-free component (B) comprising a binder and

Art Unit: 1711

water wherein a binder can be the same binder. Also, appellants do not argue that the amount of binder, water, solvent and solid content of pigments can be varied depending on the intended use of the aqueous coating composition.

Appellants' argument is that the Examiner's Answer of August 23, 2005 contains a new ground of rejection of the pending claims over Reusmann et al U.S. Patent 6,403,701 as taken individually reference.

There is no rejection of claims 3, 18-19, 21-22, 25-26 and 28 under 35 U.S.C. 103(a) as being obvious over Reusmann et al U.S. Patent 6,403,701. There is no separate paragraph of the rejection of the pending claims over Reusmann individually. There is no new ground of rejection.

Appellants' argument is that independent claim 3 is nonobvious over Reusmann' 701 in view of Kawakami' 994, because Reusmann fails to disclose all three claimed modules (I), (II) and (III) for coating composition, and there is no motivation to include the paper coating composition of the Kawakami' 994 in the system of the Patent' 701 (page 11 in the appellants' argument in the Reply Brief of April 04, 2007 and page 10 in the amendment of June 25, 2007). The claimed invention is a process in the independent claim 3, the process requires the combination of an organic solvent based base color (A1), and aqueous base color (A2), and an aqueous pigment-free mixing varnish (B). The argument is that reference to Reusmann'701 fails to disclose the claimed aqueous base color (A2) comprising a binder, color pigment and water. The

cited combination fails to provide any suggestion or motivation to do what appellant has done.

The primary reference to Reusmann discloses water-dilutable coating composition. The coloring pigment is not reactive material. The binder can be the same binder in any compositions A and B and the same binder in any addition composition. Any additional aqueous base having color pigment dispersion would be expected in the aqueous coating composition in Reusmann invention for color-imparting property for obtaining the desired shade of the aqueous coating composition, column 11, lines 64-67.

The secondary reference to Kawakami '994 discloses an aqueous coating composition on to paper substrate. The composition comprises thermosetting resin, conventional pigment, binder and water. Thermosetting resin and binder are readable in the formulation of an aqueous coating composition in the present claims and in Reusmann invention. The aqueous composition in Reusmann invention can be applied on to paper substrate, column 13, line 46.

Both references disclose aqueous coating composition comprising a colorant=pigment, binder and water. Both references disclose the same utility of using an aqueous coating composition for coating a paper substrate. For these reasons it would be obvious to combine the teachings of these two references for modifying an aqueous coating composition in Reusmann by employing a composition of Kawakami invention as addition composition based on binder, conventional pigment and water for obtaining the desired coating color and the desired solid content for a coating

composition. The prima facie case of obviousness is that the addition water containing binder with color pigment is expected in the water-dilutable coating composition Reusmann invention to control the color effect and the desired solid content in the coating composition. Thus, with regards to appellants' position that the cited references fails to provide any motivation to combine the teachings of these references is not persuasive.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

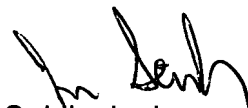
To avoid abandonment of the application, appellant must exercise one of the following two options:

Art Unit: 1711

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:




Seidleck, James.

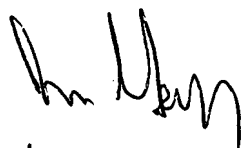
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga Asinovsky whose telephone number is 571-272-1066. The examiner can normally be reached on 9:00 to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Olga Asinovsky
Examiner
Art Unit 1711


James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700